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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,072	02/12/2001	Huei-Tarnng Liou	11993/1	9795

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EXAMINER

CLEVELAND, MICHAEL B

ART UNIT PAPER NUMBER

1762

DATE MAILED: 10/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/782,072	Applicant(s) LIOU ET AL.	
	Examiner Michael Cleveland	Art Unit 1762	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☒ they raise the issue of new matter (see Note below);

(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☒ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-5, 9 and 10.

Claim(s) withdrawn from consideration: 6-8.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.

10. ☐ Other: _____.

DETAILED ACTION

1. The proposed After Final amendment will not be entered because it raises new issues for further search and consideration, such as the clarity of the clause "including a content of aluminum-oxide sufficient to endure a temperature of 1400 °C, for an ozone generator" because it would not be clear if the clause referred to either a quartz or aluminum oxide containing tube. The claim would raise the issue of whether there were disclosure of an aluminum-oxide containing quartz capable of enduring a temperature of 1400 °C. The proposed amendment would also raise new issues for further search and consideration, such as the statement that the substrate be capable of enduring a temperature of 1400 °C, and the particular ordering of the steps.

Response to Arguments

2. Applicant's arguments filed 9/12/2003 have been fully considered but they are not persuasive.

Applicant's arguments regarding the term "high" are unconvincing because Applicant has not met the burden for being his own lexicographer of explicitly defining the term "high" in the claims, nor is there any evidence that the term "high" is art-recognized as having a particular meaning. Applicant's proposed amendments would resolve the issue, but would introduce issues of clarity.

Applicant's arguments regarding the criticality of the temperature ranges are unconvincing because they are not commensurate in scope with the claims and particularly not commensurate with the claims that do not specify the use as an ozone generator. Applicant points to passages that state that the coating adheres well, but there is no indication that coatings prepared with other baking times and temperatures do not so adhere. The argument is also unconvincing because the claims do not require using the product as an electrode in an ozone generator, nor would the proposed claims, because they do not require an active step of using the product as an electrode in an ozone generator.

Applicant argues that the phrase "after reaching 1200 °F, the substrate is allowed to cool slowly through normal radiation to room temperature (3 hours)." does not suggest retrieving the tube after the temperature in the stove is below 110 °C and putting the tube under room temperature." The Examiner disagrees. The substrate must be under room temperature (which is

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below 110 °C) if it cools to that final value, and the entire passage from lines 4-12 indicates that the substrate is not disturbed during cooling. Therefore, the passage suggests retrieving the tube from the furnace only after room temperature is reached. Further, the references makes no indication that the exterior of the furnace is kept at a temperature other than room temperature, and therefore retrieving the substrate would also necessarily be putting it under room temperature. The examiner notes that Applicant has not provided any alternate interpretation of the passage that does not meet Applicant's claim limitation.

The arguments in the affidavit are mere assertions that are unsupported by evidence. Further, Applicant's arguments in paragraphs III and IV state that temperatures outside the claimed range may lead to inferior results (emphasis added by examiner). There is no showing of the conditions which lead to the inferior results. Applicant's arguments in paragraph IV also do not represent a comparison with the closest prior art, which demonstrates retrieving the articles at 200 °C and room temperature. Finally, there is no statement that the difference in results would have been unexpected by one of ordinary skill in the art. If Applicant submits evidence demonstrating the criticality of the claimed baking range, the claims must be commensurate in scope with the showing of evidence.


Applicant's arguments regarding the attached photographs are unconvincing because there is not a complete description of the conditions under which they were produced, and therefore there is no demonstration that they are present with the claims. Because the photographs are not part of a sworn affidavit nor the sworn application, they do not constitute evidence. Applicant's arguments from p. 8 (only full paragraph) though p. 10 are therefore unsupported by a showing of fact.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cleveland whose telephone number is (703) 308-2331. The examiner can normally be reached on Tuesday-Friday and alternate Mon, 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


MBC


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